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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Pacifici
Serial No. : 09/862,976
Filed : May 22, 2001
FOR : METHOD AND COMPOSITIONS
FOR BINDING LOOSE SHEETS

Atty Ref. 32137A 070177.0163
Examiner: Carter, Monica Smith
Art Unit : 3722

AMENDMENT

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231.

Date: May 6, 2002

Attorney: Lisa B. Kole PTO Reg. No. 35,225

Lisa B. Kole
Signature

May 6, 2002
Date of Signature

Assistant Commissioner of Patents

Washington, D.C. 20231

SIR:

In response to the Official Action dated December 5, 2001, please consider the following amendments and remarks. Applicant submits herewith a Petition to Extend Time for a period of two months, up to and including Monday, May 6, 2002, together with the fee required for a small entity, estimated to be \$200.00. Applicant further includes Exhibits A and B which illustrate an embodiment of the claimed subject matter.

AMENDMENTS

IN THE SPECIFICATION:

Please replace the paragraph at page 3, lines 29-31, as follows:

Preferably, according to the invention, said band is wound, the outer surface of the support band being preferably refractory to the glue.

Please replace the first full paragraph on page 8, lines 3-7, with the following:

On the continuous band 201, at the end of the glue zone 202, a zone 205 without glue is provided, for the subsequent removal of the silicone material band, followed by a zone 206 serving to reveal, by apparatus or visually, the end of a band section and the beginning of the following one to be applied on another sheet 203.

IN THE CLAIMS:

Please cancel claims 8 and 9, without prejudice.

Please amend the claims to read as follows:

2. (twice amended) The sheet according to claim 1, having an adhesive strip and a releasably placed silicone band on both surfaces of the sheet.

7. (twice amended) A method for irreversibly binding a plurality of sheets together, comprising:

- (i) superimposing a sheet having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal over a second sheet;
- (ii) grasping the uncoupled portion of the silicone band; and
- (iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and bind the two sheets together.

10. (twice amended) An adhesive band to permanently bind loose sheets comprising a releasable silicone material support, having a substantially elongated shape alternately providing on one side portions provided with cold activated glue and shorter portions without glue.

Please add the following new claims:

19. (new) A method for irreversibly binding sheets together, comprising:

(i) superimposing a plurality of sheets, each having an adhesive strip along at least one of its edges and a silicone material band, releasably placed on said adhesive strip and having a portion uncoupled to the adhesive strip and extending beyond the sheet, such that the adhesive strips of successive sheets are superimposed;

(ii) grasping the uncoupled portion of the silicone bands extending from the successive sheets; and

(iii) pulling the uncoupled portion of the silicone bands so as to remove the silicone bands and uncover the adhesive strips, thereby binding successive sheets together.

20. (new) The method of claim 19, further comprising binding the plurality of sheets to at least one sheet that does not have an adhesive strip.

21. (new) The method of claim 19, wherein the sheets to be bound include a binding cover.

REMARKS

Claims 1-7 and 10-21 are pending. Claim 2 has been amended to clarify its subject matter. Claim 7 has been amended to no longer depend on claim 1. Claim 10 has been amended to correct a typographical error. Claims 19-21 have been added to more fully state and distinctly claim the subject matter which Applicant regards as his invention. Neither the amendments nor the new claims constitute new matter.

Claims 8 and 9 are cancelled following their withdrawal from consideration due to a restriction requirement; they are cancelled without prejudice to the prosecution of their subject matter in other patent applications.

The specification has been amended to correct a grammatical error at page 3, lines 29-31, in which the term "wounded" rather than "wound" was used. The correctness of the amendment is clear from the context of the sentence, which states that the outer surface of the support band is "refractory to the glue" - in other words, when the band is wound upon itself, the outer surface will not strongly adhere to the adhesive of the inner surface layered above it in a coil. As a grammatical correction, this amendment does not constitute new matter.

In addition, the specification has been amended to correct a typographical error in the paragraph at page 8, lines 3-7, in which the number "106" was used to refer to a component of Figure 24 in conjunction with features 201, 202 and 205. The component identified as "106" functions as a marker of the end of a band section. Reference to Figure 24 shows that an area adjacent to the end of a band section is feature 206. Clearly, the recitation "106" is an error, and the number "206" should have been used. The specification has been amended to recite "206" rather than "106"; because this numbering is consistent with Figure 24, the amendment does not constitute new matter.

Pursuant to 37 C.F.R. §1.121(b)(1), a page containing the replacement paragraph and showing the amendment, is attached hereto.

Pursuant to 37 C.F.R. §1.121(c)(1), a page containing claims 7 and 10, marked to show amendments, is attached hereto.

Further, for the Examiner's convenience, a copy of all pending claims is attached hereto.

In addition to several objections, the claims are rejected as indefinite and/or as obvious over the prior art. For reasons to be set forth below, it is requested that the objections and rejections be removed and that the claims be allowed to issue.

1. **The Invention**

The present invention relates to a simple and economical way of binding sheets which does not require expensive or complicated equipment. Sheets are provided which have a strip of permanent adhesive along the edge which is to be bound. The strip of adhesive is covered with a silicone band which extends beyond the sheet edge. To bind one sheet to another, the sheets are positioned according to how they are to be bound, and the extending portion of the silicone band is grasped and pulled away, exposing the adhesive strip and allowing adherence.

Information may be drawn, typed or printed on sheets bearing adhesive strips, and the sheets can be stacked together with their silicone band-covered adhesive strips aligned. A binding cover may be put at one end the stack, in apposition to the side of a sheet which bears a covered adhesive strip. The sheets can be held together and the protruding ends of the silicone bands grasped and pulled, so that the adhesive strips are exposed and the sheets are bound together.

As an illustration, a copy of this amendment has been printed on sheets having, according to the invention, an adhesive strip covered with a silicone band. The printed sheets, with the attached silicone bands on the unprinted side of the pages, were then covered with an acetate sheet having a silicone band-covered adhesive strip on the side of the sheet facing the pages. A cardboard binding back cover, lacking an adhesive strip, was placed underneath the lowest paper sheet in the stack, so that the silicone band of that sheet was facing the upper aspect of the cardboard cover. The acetate sheet, paper sheets, and cardboard binding back cover were aligned so that all elements were superimposed. Then, while holding the stack together, the protruding elements of the silicone bands were grasped and pulled away such that the adhesive strips were exposed and the pages bound together. The result may be seen in Exhibit A.

Applicants have also attached, as Exhibit B, a similar stack of pages where the silicone bands are still retained. The Examiner is invited to bind the pages together to

illustrate the operation of the invention. Clearly, the present invention provides an efficient and economical way to produce professional quality documents. Business travelers, students, small business concerns, and large companies that do not have 24-hour immediate access to binding machines would benefit from the invention.

2. The Drawings Are Correct

The drawings are objected to because, according to the Examiner, they do not show a "wounded" silicone band.

As explained above, use of the term "wounded" was a grammatical error, and the term "wound", indicating that the band is coiled about itself, was clearly intended. Thus, there was no claimed feature of the band that was not depicted in the figures, merely a way in which it could be stored and/or dispensed. The specification has been amended to correct this error.

Therefore, Applicant asserts that the drawings are correct in their current form so that no revision is necessary. Applicant requests that the objection be withdrawn.

3. Claim 10 Is Amended

Claim 10 is objected to for reciting "releasable_silicone". As required by the Examiner, this has been corrected, by amendment, to read "releasable silicone".

4. The Claims Are Clear And Definite

Claims 2, 14 and 17 are rejected under 35 U.S.C. §112 as being indefinite. The Examiner states:

In claim 2, it is not clear what applicant is claiming. Does applicant mean that the adhesive strip and silicone band are on opposite sides of each other or are the adhesive strip and silicone band together on opposite sides of the sheet (two different adhesive and silicone band arrangements placed on two different sides of the sheet)? In claim 14, it is not clear how the glue is "destined" to perform as claimed.

Applicant has amended claim 2 to provide clarification. The claim is intended to cover a sheet which has an adhesive strip/silicone band on both its surfaces (e.g. the top surface and the bottom surface of the sheet). Support for this amendment

can be found in the specification at page 2, lines 28-30, so that it does not constitute new matter.

With regard to claim 14, Applicant respectfully disagrees that the claim is not clear. The band has glue on both of its surfaces such that glue on one side would adhere the band to a first sheet and glue on the other side would adhere to a second sheet superimposed on the first.

Applicant further disagrees that claims 17 and 18 are not clear. In the context of the field of the invention, binding paper, it is understood that a page, depicting a text or image, for example, could be joined at an upper edge, a lower edge, or a lateral edge relative to the text or image.

It is therefore requested that these rejections under 35 U.S.C. § 112 be withdrawn.

5. The Claims Are Not Obvious

Claims 1-7 and 10-18 are rejected under 35 U.S.C. §103(a). The Examiner contends that the claims are obvious over United States Patent No. 4,789,187 by Corlew et al. ("Corlew") in view of United States Patent No. 5,658,629 by Decluve et al. ("Decluve"). The Examiner states:

Corlew et al. disclose a sheet for binding to one or more sheets and the method thereof including a sheet (11), an adhesive strip (15-self-stick adhesive) along at least one of its edges (lateral edge), a paper backing strip (16) releasably placed on the adhesive; the paper backing strip is released from the adhesive so that the sheet may be attached to a page in a magazine. Adhesives having permanent (pressure-sensitive) and temporary (releasable or repositional) properties are well-known in the art. Even though Corlew recognizes the use of a releasable adhesive for repositioning the sheet in the magazine, it would have been obvious to provide a permanent adhesive on the sheet should the user desire the sheet to permanently retain in a particular position.

The Examiner considers the claim limitations regarding the backing being larger than the adhesive and the number of adhesive bands on the sheets to be obvious variations or matters of design choice. Regarding claim 16, the Examiner states that "the method of applying the band to the sheet does not structurally limit the claim." The Examiner concludes:

Corlew disclose the claimed invention except for the adhesive strip having a silicone band that is wound. Providing a silicone band as a release liner for an adhesive is well-known in the art. Decluve et al. disclose double-sided silicone coated liners adapted for self-wound tapes for coating adhesives. The silicone paper has an advantageous elongation/shrinkage relationship as compared to glassine-type and film liners. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Corlew's invention to provide the paper backing having a silicone band, as taught by Decluve, to provide a liner having good dimensional stability at an attractive cost.

Applicant respectfully disagrees and asserts that the claims are not obvious over Corlew in view of Decluve. To render a claim obvious, the prior art must contain a suggestion to produce the claimed invention and evidence which would convey a reasonable expectation of success to the skilled artisan. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). The teaching or suggestion and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There is no suggestion to produce an essential aspect of the claimed invention, namely permanently binding sheets together, in the cited art. To the contrary, *temporary* binding is a critical component of the Corlew disclosure, which teaches a table of contents which can be removably attached to various pages of a magazine to act as a more stable bookmark (Corlew, column 1, lines 48-50) and to provide the reader with readily accessible content information (Corlew, column 1, lines 39-42). Corlew states:

It is yet another object of this invention to provide a combination bookmark and table of contents for use with such periodicals in which the table of contents or a reprinted version of it can be positioned and secured in position at any desired page location in the periodical *and then can be removed and repositioned at another page location* as the reader so desires (Corlew, column 1, lines 59-65, *emphasis added*); and

The indicia page carries means for *removably reattaching* the indicia page to any one of the other individual pages of the bound volume (Corlew, column 2, lines 34-36, *emphasis added*).

In view of the fundamental purpose of removable attachment, Corlew provides no suggestion or motivation whatsoever for permanent binding. Therefore the claimed invention, which requires permanent binding, cannot be rendered obvious by

Corlew. Decluve, which merely teaches a double-sided silicone coated liner, adds nothing to the Corlew disclosure which would make permanent binding according to the pending the claims obvious.

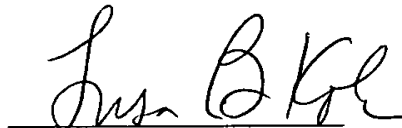
Applicant provides herewith, as Exhibits A and B, working examples of the operation of the claimed invention which clearly illustrate its distinction over the prior art. The Examiner is asked to consider these examples as evidence of the non-obvious nature of the invention.

In view of these arguments and evidence, it is requested that the rejection of the claims under 35 U.S.C. §103 be withdrawn.

6. **Conclusion**

For all the foregoing reasons, it is requested that all the objections and rejections be withdrawn and that the claims be allowed to issue. This paper is signed under 37 C.F.R. §1.34(a); a Power of Attorney appointing attorneys of Baker Botts, L.L.P., including the undersigned, will be provided.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Lisa B. Kole", written over a horizontal line.

Lisa B. Kole
PTO Reg. No. 35,225
(212) 408-2628

May 6, 2002

Baker Botts, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

REPLACEMENT PARAGRAPHS SHOWING CHANGES

The paragraph at page 3, lines 29-31, is amended as follows to generate the first replacement paragraph:

Preferably, according to the invention, said band is wound [wounded], the outer surface of the support band being preferably refractory to the glue.

The first full paragraph on page 8, lines 3-7, is amended as follows to generate the first replacement paragraph:

On the continuous band 201, at the end of the glue zone 202, a zone 205 without glue is provided, for the subsequent removal of the silicone material band, followed by a zone 206 [106] serving to reveal, by apparatus or visually, the end of a band section and the beginning of the following one to be applied on another sheet 203.

CLAIMS MARKED TO SHOW CHANGES

2. (twice amended) The sheet according to claim 1, having an adhesive strip and a releasably placed silicone band on [opposite] both surfaces of the sheet.

7. (twice amended) A method for irreversibly binding [at least two] a plurality of sheets together, comprising:

(i) superimposing [the] a sheet having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal [according to claim 1] over a second sheet;

(ii) grasping the uncoupled portion of the silicone band; and

(iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and bind the two sheets together.

10. (twice amended) An adhesive band to permanently bind loose sheets comprising a releasable[] silicone material support, having a substantially elongated shape alternately providing on one side portions provided with cold activated glue and shorter portions without glue.

PENDING CLAIMS

1. (amended) A sheet for permanent binding to one or more additional sheets, having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal and the binding.

2. (twice amended) The sheet according to claim 1, having an adhesive strip and a releasably placed silicone band on both surfaces of the sheet.

3. (amended) The sheet according to claim 1, wherein an adhesive strip is provided on an edge selected from the group consisting of an upper edge, a lower edge, and a lateral edge.

4. (amended) The sheet according to claim 1, wherein an adhesive strip is close to the edge of the sheet .

5. (amended) The sheet according to claim 1 as comprised in a continuous snap out of sequential sheets, provided with lateral dragging bands, wherein the uncoupled portion of the silicone band is coupled by weakening lines with the band of the following sequential sheet.

6. (amended) The sheet according to claim 1 wherein a portion of the silicone band is larger than said glue or adhesive tape strip, and can be folded outwardly during bonding, said portion of the silicone band larger than the glue or adhesive tape strip being the uncoupled portion.

7. (twice amended) A method for irreversibly binding a plurality of sheets together, comprising:

(i) superimposing a sheet having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal over a second sheet;

(ii) grasping the uncoupled portion of the silicone band; and

(iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and bind the two sheets together.

10. (amended) An adhesive band to permanently bind loose sheets comprising a releasable silicone material support, having a substantially elongated shape alternately providing on one side portions provided with cold activated glue and shorter portions without glue.

11. (amended) The adhesive band according to claim 10 wherein the band is continuous and comprises sections which each comprise a portion provided with cold activated glue and a shorter portion without glue, and having, at the end of each section a feature selected from the group consisting of a cut facilitation, a breaking line, an optical signal and a mechanical signal to indicate a cutting point.

12. (amended) The adhesive band according to claim 10, wherein the function of the portion without glue is to provide the opportunity for an easy removal of

the silicone support which after the application of the glue on the sheet has the function of preventing undesired adhesion prior to binding.

13. (amended) The adhesive band according to claim 10 wherein said band is wounded, the outer surface of the support band being preferably refractory to the glue.

14. (amended) The adhesive band according to claim 10 wherein the glue-providing portions have glue on two surfaces, one of which is destined to adhere to the sheet to be bound, the second one being destined to adhere to the sheet that during the binding will be coupled to the sheet providing the band.

15. (amended) The adhesive band according to claim 10 wherein said band is applied on both sides of a sheet.

16. (amended) The adhesive band according to claim 10 wherein said band is applied to a sheet by a method selected from the group consisting of manual application, application by a suitable device, and application by a printer.

17. The sheet according to claim 2, wherein an adhesive strip is provided on an edge selected from the group consisting of an upper edge, a lower edge, and a lateral edge.

18. The sheet according to claim 2, wherein an adhesive strip is close to the edge of the sheet.

19. (new) A method for irreversibly binding sheets together, comprising:

(i) superimposing a plurality of sheets, each having an adhesive strip along at least one of its edges and a silicone material band, releasably placed on said

adhesive strip and having a portion uncoupled to the adhesive strip and extending beyond the sheet, such that the adhesive strips of successive sheets are superimposed;

(ii) grasping the uncoupled portion of the silicone bands extending from the successive sheets; and

(iii) pulling the uncoupled portion of the silicone bands so as to remove the silicone bands and uncover the adhesive strips, thereby binding successive sheets together.

20. (new) The method of claim 19, further comprising binding the plurality of sheets to at least one sheet that does not have an adhesive strip.

21. (new) The method of claim 19, wherein the sheets to be bound include a binding cover.